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Cord F. Stahler

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.

1425 K STREET, N.W.

SUITE 800

WASHINGTON, DC 20005

EXAMINER

GROSS, CHRISTOPHER M

ART UNIT

PAPER NUMBER

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NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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ADVISORY ACTION

Continuation of 3 and 13

On the one hand, applicant's 5/6/2010 proposed amendment appears to distinguish the claimed subject matter set forth in claims 39 and 55 from that of Heller et al with regard to anticipation under 35 USC 102 by narrowing the scope of passing of a liquid with receptor building blocks in step b and immobilizing receptor building blocks by photoactivation of the support in step c. On the other hand, applicant's proposed amendments do *not* address obviousness under 35 USC 103 when Heller et al is combined with Winkler et al, who teach, for instance light directed synthesis in the abstract and in particular NVOC protected monomers (photolytically cleavable protected receptor building blocks) in column 15 line 48 and column 26 line 51: one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For informational purposes, while the figures are not clear due to a reproduction artifact, applicant is advised the Kreiner reference (11/5/2009 IDS) concerning sequencing-by-hybridization using the Affymetrix apparatus appears to further render the claimed subject matter at least obvious, especially in view of *Anderson's-Black Rock, Inc. v. Pavement Salvage Co. (Anderson)*, 396 U.S. 57, 163 USPQ 673 (1969); *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385, 1395 (2007) and the discussion in MPEP 2141 section III (A) and 2144.04(V)(B) which indicates the courts have consistently held combining prior art elements (such as an

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paving machine which combined several well-known elements onto a single [integral] chassis in *Anderson* and reiterated in *KSR*) according to known methods to yield predictable results is obvious.

Applicant's proposed amendment to claim 45, while addressing the objection to the specification and 35 USC 112 second paragraph rejection of record regarding the metes and bounds of "negative" receptors, the claim now appears to constitute new matter under 35 USC 112 first paragraph since the disclosure as originally filed provided no implicit or explicit support for excluding all of the receptors from the preceding cycle and starting anew. Please note that while "negative" receptor, as previously presented, constituted an indefinite limitation for the reasons set forth in the last office action, it still would be indicative of at least some subset of receptors. Additionally, in reference to claim 44, from which proposed amended claim 45 depends, it is also not clear how it is possible to modify any receptors from the preceding cycle if they are excluded.

To be sure, for the reasons set forth above, the proposed amendment requires additional search and consideration, does not materially reduce or simplify the issues for appeal and there is no reason why the proposed amendments were not presented earlier in prosecution. See 37 CFR 1.116 (c).

In light of the fact that the proposed amendments, filed 5/6/2010, after final rejection will not be entered, Applicant's arguments filed 5/6/2010 (see p 7-9) are rendered moot.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER M. GROSS whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571 272 0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

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/ Christopher S. F. Low /
Supervisory Patent Examiner, Art Unit 1639